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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/609,142	Applicant(s) FORLAI, LUIGI	
	Examiner Narayanswamy Subramanian	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15, 62-72 and 74-96 is/are pending in the application.
- 4a) Of the above claim(s) 2-8, 10-15, 63, 64, 70-72, 86-89 and 93-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 62, 65-69, 74-85 and 90-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

EA

DETAILED ACTION

1. This office action is in response to applicants' communication filed on August 8, 2005. Election of group I claims and election of species IA3 in that group, in response to election/restriction, is acknowledged by the examiner. Claims 1-8, 10-15, 62-72 and 74-96 are pending in the application. Applicants are respectfully advised to cancel claims 2-8 and 10-15 pertaining to the non-elected invention. Claims 1, 62, 65-69, 74-85 and 90-92 have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 76, 83-85 and 90-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Clarification is required.

In claim 1, the limitation "less than a market value of the offered product or service" is vague and unclear. It is not clear what the applicant means by "market value". The applicant does not disclose how this market value is obtained or determined for a comparison to be made with the offer price. Clarification is required.

In claim 76, it is not clear what the applicant means by "offer price substantially equal to a discounted value less than a market value of the offered product or service plus a delivery price associated with the sale offer transaction". The term "market value" is not clear as discussed above. It is also not clear if the delivery price is added to the discounted value or the market value. Clarification is required.

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In claims 83-85 and 90-92, it is not clear what the applicant means by “a discounted product or service at a price substantially equal to the delivery price of the product or service”.

It is not clear as to what determines if a product is discounted or not? The discount is with respect to what value? Clarification is required.

Art rejections that follow are interpreted in light of the 35 USC § 112, second paragraph rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 62, 65, 68, 69 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698).

With reference to claim 1, Odom teaches a method of making a sale offer over an electronic network system, comprising the steps of: randomly generating an offer to purchase a product or service on the electronic network system at an offer price that is less than a market value of the offered product or service (See Odom Column 3 lines 20-26, the offer price is interpreted to be less than the price at which the product is sold by other dealers. The sale price one sees everywhere is an example of this phenomenon and this is commonly done as an incentive to the buyers); communicating the randomly generated offer through the electronic network system at an unknown start time and for a predetermined

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duration of time to one or more potential buyers connected to the electronic network system (See Odom Column 3 lines 20-26, Column 5 lines 22-25, lines 46-50 and claim 1, unknown start time is interpreted to mean unknown start time to the buyer); completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by a buyer within the predetermined period of time (See Odom Abstract and Column 3 lines 43-46); and removing the offer from the electronic network system should the buyer not accept the offer within the predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

With reference to claim 62, Odom teaches a method of making a sale offer over an electronic network system, comprising: randomly displaying at least one offer to accept a product or service at an offer price to a one or more potential recipients on the electronic network system (See Odom Column 3 lines 20-26) at an unknown start time (See Odom

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Column 3 lines 20-26, Column 5 lines 22-25, lines 46-50 and claim 1, unknown start time is interpreted to mean unknown start time to the buyer); providing an opportunity for the one or more potential recipients on the electronic network system to accept the at least one randomly displayed offer within a limited duration of time (See Odom Column 5 lines 12-25); receiving an indication of acceptance of the randomly displayed offer from the one or more potential recipients on the electronic network system (See Odom Column 6 lines 27-33); completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by the one or more potential recipients on the electronic network system (See Odom Column 6 lines 27-65); and removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the limited duration of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). The seller can withdraw the offer anytime at seller's option, which includes removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the limited duration of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The

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combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

With reference to claims 65, 68 and 69, Odom teaches randomly displaying a plurality of offers on the electronic network system during a predetermined period of time (See Odom Column 5 lines 45-56 and Column 10 lines 10-14); selecting one of a plurality of different types of product or services offered to the one or more potential recipients on the electronic network system (See Odom Column 5 lines 45-56, automatic identification implies this feature) and selecting one of a plurality of different types of products or services offered based on a profile of the one or more potential recipients on the electronic network system (See Odom Column 5 lines 45-56, automatic identification and e-mailing implies this feature).

With reference to claim 90, Odom teaches a method of randomly offering discounted products or services over an electronic network system, comprising: a step for randomly displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service (See Odom Column 3 lines 20-26, the offer price is interpreted to be less than the price at which the product is sold by other dealers. The sale price one sees everywhere is an example of this phenomenon and this is commonly done as an incentive to the buyers), the randomly displayed offer having an unpredictable start time (See Odom Column 3 lines 20-26, Column 5 lines 22-25, lines 46-50 and claim 1, unknown start time is interpreted to mean unknown start time to the buyer); a step for providing an opportunity for the one or more potential recipients on the electronic network system to accept the randomly displayed offer within a predetermined duration of time (See Odom Column 5 lines 12-25); a step for receiving an indication of acceptance of the randomly displayed offer from the one or more potential recipients on the

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electronic network system (See Odom Column 6 lines 27-33); a step for completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by the one or more potential recipients on the electronic network system (See Odom Abstract and Column 3 lines 43-46); and a step for removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the predetermined duration of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). The seller can withdraw the offer anytime at seller's option, which includes removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the limited duration of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

6. Claims 74-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698) and further in view of Conklin et al (US Patent 6,141,653).

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With reference to claim 74, Odom teaches a method of claim 62 as discussed above including a first indication of acceptance from the buyer in response to the random display of the at least one sale offer (See Column 6 lines 27-33), negotiation between the seller and the buyer (See Odom Column 6 lines 11-19) and clearing the transaction (Column 3 lines 43-46 and Column 7 lines 56-60) and requesting delivery of the offered product or service to the buyer (inherent in the disclosure of Odom).

Odom does not explicitly teach the steps of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Conklin teaches the steps of iteratively negotiating multiple variables, documenting the transaction, providing payment options and transferring the payment amount online (See Conklin Column 14 lines 3-31 and lines 63-65). These steps are common in trading between two parties to a transaction. The disclosure of Conklin is interpreted to include the features of displaying at least one term associated with the at

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least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Both Conklin and Odom are concerned with the problem of facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Conklin. The combination of disclosures suggests that both parties to the transaction would have benefited from the smooth negotiations and conclusion of the transactions provided by the disclosures.

With reference to claims 75 and 76, Tuck teaches the step wherein the at least one term associated with the randomly generated sale offer comprises an offer price substantially equal to a delivery price associated with the sale offer transaction (See discussion of claim 1 above). The offer price is interpreted to include a discounted price as discussed in claims 1 and 62 above.

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With reference to claims 77-82, Odom teaches at least one payment method option comprises a credit card payment option or a cash-upon-delivery payment option (See Odom Column 12 lines 33-35); the step of withdrawing the at least one randomly generated sale offer in the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the at least one randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, the seller can withdraw the offer anytime at seller's option, which includes the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying); the step of withdrawing the at least one randomly generated sale offer in the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the at least one term associated with the at least one randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, the seller can withdraw the offer anytime at seller's option, which includes the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the at least one term associated with the at least one randomly generated sale offer; the step of withdrawing the at least one randomly generated sale offer in the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the acceptance form (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, the seller can withdraw the offer anytime at seller's option, which includes the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the acceptance form); the step of withdrawing the at least one randomly

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generated sale offer in the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the at least one payment method option (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, the seller can withdraw the offer anytime at seller's option, which includes the event the potential recipient does not indicate acceptance within a predetermined period of time after the step of displaying the at least one payment method option); and determining if a predetermined monetary amount is available to transfer from the potential recipient to the seller (See Odom Column 11 lines 23-27 and Column 12 lines 33-35).

7. Claims 66, 67, 83-85, 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698) and further in view of Smith (US Patent 6,502,076 B1).

With reference to claim 83, Odom teaches a method of randomly offering discounted products or services over an electronic network system, comprising: randomly displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service (See Odom Column 3 lines 20-26, the offer price is interpreted to be less than the price at which the product is sold by other dealers. The sale price one sees everywhere is an example of this phenomenon and this is commonly done as an incentive to the buyers), the randomly displayed offer having an unpredictable start time (See Odom Column 3 lines 20-26, Column 5 lines 22-25, lines 46-50 and claim 1, unpredictable start time is interpreted to mean unpredictable start time to the buyer); providing an opportunity for the one or more potential recipients on the electronic network system to accept the randomly displayed offer within a predetermined duration of time (See

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Odom Column 5 lines 12-25); receiving an indication of acceptance of the randomly displayed offer from the one or more potential recipients on the electronic network system (See Odom Column 6 lines 27-33); completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by the one or more potential recipients on the electronic network system (See Odom Abstract and Column 3 lines 43-46); and removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the predetermined duration of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). The seller can withdraw the offer anytime at seller's option, which includes removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the limited duration of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

Odom does not explicitly teach the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner.

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Smith teaches the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner (See Smith Column 6 lines 46-54 and Column 17 lines 17-20).

Both Smith and Odom are concerned with the problem of providing information to buyers to facilitate selling of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Smith. The combination of disclosures suggests that sellers would have benefited from being able to target different buyers by randomly varying the times when products are offered.

With reference to claims 66, 67, 84, 85, 91 and 92, Smith teaches controlling the frequency of randomly displaying the plurality of offers on the electronic network system (See Smith Column 2 line 63 – Column 3 line 5, the weighting factor controls the frequency); and increasing a number of unknown sale offer start times when a number of potential recipients on the electronic network system increases (See Smith Column 4 line 51 – Column 5 line 64 and Column 6 lines 30-65, tailoring the ads and specifying in the attract loop the weighting factor is interpreted to include this feature).

Response to Arguments

8. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

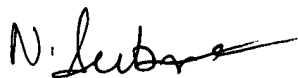
- (a) Van Luchene (US Patent 6,223,163 B1) (April 24, 2001) Method and Apparatus for Controlling Offers that are provided at Point-of-sale Terminal
- (b) Wilkinson (US Patent 4,571,546) (February 18, 1986) Digital Random Error Generator Supplying Burst Error Signals of Random Durations Starting at Random Times
- (c) Tavor et al (US Patent 6,553,347 B1) (April 22, 2003) Automatic Virtual Negotiations
- (d) Meyer et al (US Patent 6,915,271 B1) (July 5, 2005) Method and System for Delivering Redeeming Dynamically and Adaptively Characterized Promotional Incentives on a Computer Network
- (e) Conklin et al (US Patent 6,338,050 B1) (January 8, 2002) System and Method for Providing and Updating User Supplied Context for a Negotiating System

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For

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more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "N. Subramanian", with a long horizontal stroke extending to the right.

Dr. N. Subramanian

October 16, 2005